

REMARKS/ARGUMENTS

Reconsideration and allowance of the present application based on the following remarks are respectfully requested. Claims 1, 3, 6 and 10-12 have been amended. Claims 18-34 have been added. Claim 2 has been cancelled. Support for the additions and the amendments may be found throughout the specification. No new matter has been added. Upon entry of the above amendments, claims 1 and 3-34, as amended, will be pending.

Claims 1-17 have been rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent 4,602,079 to Vinches *et al.* ("Vinches") in view of U.S. Patent 5,840,782 to Limerkens *et al.* ("Limerkens").

With respect to the 35 U.S.C. § 103(a) rejection, the amendments to the claims are believed to address this rejection. Respectfully, the examiner has failed to establish a *prima facie* case of obviousness. Preliminarily, both the use of dimers and foaming are known to those of ordinary skill in the art to degrade the mechanical properties of polyurethanes. Thus, one of ordinary skill in the art seeking to make polyurethane foams with good mechanical properties would not be motivated to combine the teachings of Vinches and Limerkens by combining these two weakening effects. Respectfully, the Examiner is impermissibly using hindsight to reconstruct Applicants' patent from prior art with no motivation provided for combining the references. The Federal Circuit has made it clear that obviousness cannot be established simply by stitching together pieces of prior art using the patent as a template. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143 (Fed. Cir. 1985); see also Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 873 (Fed. Cir. 1985) (denouncing courts' tendency to depart from proper standard of nonobviousness "to the tempting but forbidden zone of hindsight"); In re Fine, 837 F.2d 1071, 1075 (Fed. Cir. 1988) ("One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention").

The Examiner attempts to manufacture a motivation to combine the references by asserting that since both Limerkens and Vinches include water, one of ordinary skill in the art would have been motivated to form foams of Limerkens using the compositions of Vinches. The Examiner has failed to indicate how the presence of water in two different compositions for two different uses would motivate one of ordinary skill to take an elastomer composition (*i.e.*, not a composition used for

foams) to form a microcellular foam. Respectfully, the Examiner has failed to meet his burden.


In addition, Applicants have unexpectedly discovered microcellular foam polyurethanes that include dimers that have mechanical properties at least as good as foamed polyurethanes that do not include dimers (See Examples 1 and 2 in comparison to comparative Examples 3 and 4). Neither of the references suggests these results. Furthermore, neither reference suggests microcellular foams formed from an isocyanate-terminated prepolymer and a polyester that are both formed from a dimer fatty acid and/or dimer fatty diol. Finally, the references do not suggest microcellular foams that retain at least 40% of their initial tensile strength after being subjected to hydrolysis for 2 weeks. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

Therefore, all objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance and a Notice to that effect is earnestly solicited.

Should any issues remain unresolved, the Examiner is encouraged to contact the undersigned attorney for Applicants at the telephone number indicated below in order to expeditiously resolve any remaining issues.

Respectfully submitted,

MAYER BROWN ROWE & MAW LLP

By: 
John E. Mauk
Registration No. 54,579
Direct No. (202) 263-3255

Paul L. Sharer
Registration No. 36,004
Direct No. (202) 263-3340

Intellectual Property Group
1909 K Street, N.W.
Washington, D.C. 20006-1101
(202) 263-3000 Telephone
(202) 263-3300 Facsimile

Date: May 5, 2006